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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,037	03/19/2001	Ian E. Smith	D/A0458	9334

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EXAMINER

GODDARD, BRIAN D

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 02/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/812,037

Applicant(s)

SMITH ET AL.

Examiner

Brian Goddard

Art Unit

2171

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 20 January 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: _____

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☒ Other: See Continuation Sheet


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Continuation of 5. does NOT place the application in condition for allowance because: Applicants' arguments are not persuasive.

Referring to applicants' remarks on page 6, applicants argued that Rosati does not describe designating a first selected object as a representation of a group. In response to applicants' arguments against the references individually, one cannot show nonobviousness by attacking references individually when the rejection is based on a combination of references. Rosati's teaching of the importance of a first selected object being greater than that of subsequently selected objects in an ordered display would have provided sufficient suggestion to one of ordinary skill in the art at the time the invention was made for designating the first selected object as the representative in Ukai, since Ukai's system already designated a representative of a group. Furthermore, it is noted that applicants' arguments against the Rosati reference are based on its teaching that all of the selected parameters are displayed, while applicants' own claimed invention displays "the plurality of objects" WITH the representative of the group (final limitation of claim 1), wherein "the plurality of objects" includes all objects of the group. Thus, applicants' arguments are contradictory to applicants' own claimed invention.

Referring to applicants' remarks on page 7, applicants argued that Rosati comes from a completely different technology area than Ukai and the present invention, and that it would not be obvious to combine these references for this reason. In response to applicant's argument that Rosati is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Rosati is considered reasonably pertinent to the particular problem with which the applicant was concerned, that being the grouping, ordering, and display of a plurality of objects. This technology is clearly present in Rosati, and is significantly analogous to the technologies of Ukai and the present invention.

Continuation of 10. Other: Applicants' "amendment" on pages 2-5 of the reply does not contain any modifications to the claims. Therefore, the reply is considered a request for reconsideration, and not a proposed amendment..